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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,590	07/09/2003	Mark Van Gorp	63288-605	8943
7590 12/12/2007 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER QIN, YIXING	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/615,590

Applicant(s)

GORP ET AL.

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) .
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/2/07 have been fully considered. The arguments begin by discussing how the newly amended claims distinguish over the prior art due to the addition of the last four limitations of claim 44. The Examiner has found a new reference, Hill (U.S. Patent No. 6,467,687) to teach/suggest these features. The Hill reference is a credit card packaging system. The system allows for a credit card to be packaged with various forms related to a user of the credit card. Hill's system simply does not split the forms to be printed to multiple printing stations and then collate them back together. The previously cited reference, Roberts teaches/suggests these features.

The arguments say that the Roberts reference do not teach the scanning of the collated document. However, in review of the Roberts reference and the Hill reference, there is enough information provided to at least suggest the claimed features. The Roberts reference shows in Fig. 7 that his invention has all the appropriate modules to perform a scanning of an identifier of each and every page of a document. Roberts simply does it as they come in instead of after it's been merged. However, it would seem that the results would be the same as the claimed invention, all pages of a document are verified to be proper. In addition, the Hill reference also discloses in Fig. 5A, item 114 that all items are compared and verified.

Arguments are also presented in regards to the Farrell reference. Due to the amendments to the claims, and the usage of the Hill reference, the Farrell reference is no longer needed in the rejection of the independent claims.

Additional cited prior art reference such as Jones are selectively used to help rejecter certain dependent claims.

Claims 52 and 56 are similarly analyzed as claim 44 above.

The rejection is thus made final due to the new grounds of rejection based upon amended claims. Please see the rejection below for more details.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44-46, 48-53, 55-57 rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (U.S. Patent No. 6,467,687) in view of Roberts et al (U.S. Patent No. 6,650,431)

Regarding claims 44, 52, 56, the Hill reference discloses A method for forming a document to be created from multiple resources, in accordance with document attributes, the method comprising steps of:

receiving a soft copy of a part of the document which is to be printed; (Fig. 5A, item 100->108 is form data)

Hill does not explicitly disclose the next few limitations regarding the splitting up of the data and sending them to different printers.

However, Roberts, as mentioned in the previous rejection discloses :
generating multiple print files from the soft copy; (Fig. 4, Items 402, 404 show color and black and white pages separated in a print job)

applying the multiple print files to individual printers to print corresponding document portions from the print files; (Fig. 1, items 124, 126)

collating the printed document portions from the printers into a single collated hard copy portion of the document; (Fig. 1, item 114)

Hill and Roberts are combinable because both are in the art of combining various portions of document together to make a final document.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a multiple printer printing method like that of Roberts in the Hill invention.

The motivation would have been to allow a quicker way to print larger or complex documents.

Therefore, it would have been obvious to combine Hill and Roberts to obtain the invention as specified.

Hill further discloses scanning one or more sheets of the collated hard copy portion of the document to detect an identifier on the collated hard copy portion of the document; (Fig. 5A, column 12, lines 25-34)

adding an auxiliary item, not printed from a print file from the soft copy, to the collated hard copy portion of the document to form the final document; (Fig. 5A, items 102, 104, 106 - is the flow for making a card to be inserted into the final package)

scanning the auxiliary item to detect an identifier on the auxiliary item; (Fig. 5A, column 12, lines 25-34) and

verifying completion of the final document in accordance with the document attributes, based at least in part on the detected identifiers. (Fig. 5A, column 12, lines 35-55.

Regarding claim 45, Hill discloses the method of claim 44, wherein the auxiliary item comprises a credit card. (Fig. 5A)

Regarding claims 46, 53, Hill discloses the method of claim 44, wherein the step of adding an auxiliary item is responsive to the detected identifier on the collated hard copy portion of the document. (Fig. 5A, item 114, 5B – Hill discloses that two different checks are made and that the addition of the card to create the final document is in response to both the card and the form being correct.)

Regarding claim 48, Hill discloses the method of claim 44, wherein at least one step of scanning to detect an identifier comprises scanning to capture information from bar code. (Fig. 5A, item 121 is a check for embossing and encoding.)

Regarding claim 49, Hill discloses the method of claim 44, wherein at least one step of scanning to detect an identifier comprises recognition of one or more characters. (Hill discloses in Fig. 5A, 5B that the verification of the card is on embossing/encoding and the detection of the form is by rereading. This would comprise at least recognizing one character since it is rereading a form)

Regarding claim 50, Hill discloses the method of claim 44, wherein at least one step of scanning to detect an identifier comprises recognition of a graphic. (Fig. 5B, item 121 discloses recognition of an embossing, so that can be considered a graphic)

Regarding claims 51, 55, Hill discloses the method of claim 44, wherein the step of verifying completion comprises comparing the detected identifiers to desired attributes for the final document specified in a data file for the document to be created. (Fig. 5B. shows that the form is reread and compared to the computer file. The computer file inherently consists of attributes for the document to be created, so the comparison who be with identifier on the form against attributes that would identify the identifiers as something else)

Regarding claim 57, Hill discloses the system of claim 56, further comprising at least one scanning device in communication with the computer for scanning the collated hard copy portion of the document and the auxiliary item and supplying data related to the identifiers to the computer (Fig. 5B discloses a method for verifying documents, so the system in Fig. 1 would inherently have some module for performing this task.)

Claims 47 and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (U.S. Patent No. 6,467,687) in view of Roberts et al (U.S. Patent No. 6,650,431) and further in view of Jones et al (U.S. Patent No. 7,034,951)

Regarding claims 47, 54, the Roberts reference discloses a method of distributed printing.

It does not explicitly disclose "detecting an error in a prior collation of the hard copy portion of the document;

wherein the step of applying the multiple print files to individual printers includes supplying a command to reprint at least one of the corresponding document portions responsive to the detecting of the error."

However, Jones discloses in Fig. 3, item 110, and column 6, lines 6-34 that unmatched pages needs to be reprinted.

All references are combinable because they are in the art of merging documents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have reprinted unmatched or wrong pages.

The motivation would have been to reprint pages that were wrongly printed so that the document can be formatted correctly.

Therefore, it would have been obvious to combine all references to obtain the invention as specified.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YQ



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